

Remarks

Claims 1 to 5, 7 to 14, and 17 to 21 are pending.

Claims 15 and 16 have been cancelled. New claim 21 is presented for consideration by the Examiner.

The Examiner has rejected claims 1-5, 7, 8, 12-14 under 35 USC 102(a)/103(a) as obvious in view of WO 02/30647 to Bachmann ("Bachmann") and one or more of other cited references. An affidavit pursuant to 37 CFR 1.131 by the inventor Ms. Renuga Gopal is being filed concurrently herewith. The Affidavit establishes that the claimed invention was reduced to practice in Singapore, a WTO member country, prior to April 18, 2002, the effective date of Bachmann under 35 USC 102/103. As evidenced by the Affidavit, an apparatus for the claimed process existed and was used to practice the claimed process prior to April 18, 2002; and the claimed process worked for its intended purpose. As such, withdraw of the citation of Bachmann as a reference under 35 USC 102/103, is requested. Similarly, withdrawal of all claim rejections based at least in part on Bachmann, is respectfully requested.

The Examiner further rejected claims 1-5, 7-8, 12-14, 17 and 18 under 35 USC 103(a) as being unpatentable over Sharrow in view of Moraschetti, and asserted that it would be *prima facie* obvious to incorporate the method of Moraschetti (i.e. to place fibers in a tube with a curable lubricating agent) into that of Sharrow. Applicants respectfully traverse this rejection.

MPEP 2143 provides that to establish a *prima facie* case of obviousness, three basic conditions must be met:

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (2) There must be a reasonable expectation of success.

- (3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

“The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure.”

Further, MPEP 4143.01 paragraph V provides that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”.

Careful review of Sharrow and Moraschetti reveals that their combination proposed by the Examiner would render Sharrow unsatisfactory for its intended purpose. Specifically, Sharrow repeatedly discloses that the heat-shrinkable tube is to be shrunk to “tightly grasp” the conductor bundle therein (see e.g. col. 2, ll. 1-11, 47-50; 53-56, and 65-68; col. 3, ll. 5-6, 41-42, and 44-45; col. 4, ll. 4-5 and 28). Inserting a curable lubricating agent disclosed in Moraschetti into the tube of Sharrow before the tube is shrunk would prevent the tube from tightly grasping the conductor bundle when the tube is shrunk. The presence of the lubricating agent would allow the conductor bundles to move about when and after the tube is shrunk (see e.g. col. 5, ll. 26-28 of Moraschetti, which discloses that the “uncured lubricant facilitates a mutual gliding motion of adjacent fibers”), and some of the lubricating agent would also remain between the conductor bundle and the shrunk tube to allow gliding motion therebetween. As such, there is no suggestion or motivation in the prior art to combine these two references as suggested by the Examiner, and a *prima facie* case of obviousness has not been established. In fact, Sharrow teaches away from the modification suggested by the Examiner, as adding a lubricant would prevent the tube from tightly grasping the bundle therein after shrinkage.

The Examiner suggests two possible motivations for combining these two references: (a) the curable material would provide enhanced protection and improved abrasion resistance; (b)

the curable material would function as an encapsulant in the same manner as the shellac disclosed in Sharrow.

With regard to motivation (a), it is noted that including a curable lubricating agent would substantially increase material and processing cost and complexity to the Sharrow process. Since the tube of Sharrow already provides sufficient protection and abrasion resistance, any further improvement, if there were any, provided by the lubricating agent would be insignificant as the lubricating agent would be covered by the tubing, thus rendering such modification very cost-ineffective. Therefore, a person skilled in the art would not have been motivated to make the suggested modification for the purpose of (a).

With regard to motivation (b), Sharrow discloses that “[a]fter the armature coil of FIG. 3 is formed, it receives a common insulating treatment which may comprise saturating the coil sides with shellac” (col. 3, ll. 55-58, emphasis added). Thus, it is clear that the shellac is applied to the exterior of the coil and the shrunk tube, not inside the tube. Thus, even assuming the shellac could be replaced by the lubricating agent, this would not provide a motivation for inserting the lubricating agent into the tube before the coil has been formed.

Therefore, withdrawal of this rejection is respectfully requested.

The Examiner also rejected claims 9-11, 19 and 20 under 35 USC 103(a) as obvious over Sharrow in view of Moraschetti and Gary. As the additional cited reference, Gray, does not cure the defect of Sharrow and Moraschetti discussed above, withdrawal of these rejections is also respectfully requested.

No new matter has been added by this amendment.

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In view of the foregoing, reconsideration and allowance of this application is earnestly solicited.

Respectfully submitted,

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